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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,367	08/27/2003	Takayuki Iida	Q77076	3701
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SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			STEIN, JULIE E	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/648,367	IIDA, TAKAYUKI	
	Examiner Julie E. Stein, Esq.	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 and 11-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 and 11-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 August 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602. The declaration does not indicate that the declaration applies to the "attached" application or the serial number and date of filing of the application.

Specification

For purposes of the Office Action, claims 7, 15, and 28 are being treated as independent claims as supported by MPEP section 2173.05(f).

3. The specification is objected to because it does not contain support for claims 7 to 9. Specifically, the specification does not contain written support for a printing system comprising an image server connected to at least one wireless communication

apparatus as recited in claim 1, which itself recites a printing system and a mini-laboratory.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 21 to 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. There is no support within the originally filed application for a *printing system* that includes an image server and a wireless communication apparatus as recited in claim 15, which includes wireless communication equipment and temporary memory, wherein the wireless communication equipment is connected via a wired communication line to a printing system—therefore there appears to be a separate printing system within the claimed printing system. Nor is there support within the originally filed application for this printing system to include an image server connected to more than one wireless communication apparatus.

6. Claims 7-9, 21-23, and 28 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use

Art Unit: 2617

the invention. There is insufficient description within the originally filed specification to enable one of ordinary skill in the art to make and/or use the invention recited in independent claims 7, 21 and 28, which in part recite a printing system within a printing system. The first printing system is within the recited language of incorporated claim 15 under MPEP section 2173.05(f) and the second printing system is the claimed printing system, which incorporates the entire recited claim.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 is indefinite because "image data" is used three times within the claim but it is unclear whether the "image data" is the same "image data" throughout the claim. In addition, if the "image data" is the same throughout the claim, then it is unclear how the data is being moved from one element of the wireless communication apparatus to the other as there is no recited connection between the elements.

Art Unit: 2617

10. Claim 1 is further indefinite because it is completely unclear what the relationship or significance is of the “wireless communication equipment” to the wireless communication apparatus.

11. Claim 2 is indefinite because it recites “image data,” that has been sent from the wireless communication apparatus to the image server, but it does not indicate, which specific “image data” is being referred to.

12. Claim 6 is indefinite because it also recites “image data,” that is being sent, but does not indicate, which image data.

13. Claim 7 is indefinite because the recited printing system incorporates indefinite claim 1 and further recites storing the image data, as in claim 2.

14. Claim 7 is indefinite because it is unclear how the image server is connected to the wireless communication apparatus via the “wired communication line” when the “wired communication line” recited in claim 1 is not connected to the wireless communication apparatus.

15. Claim 14 is indefinite because it is unclear what is meant by the limitation that the temporary storage means are upstream” from the “wired communication line.”

16. Claim 15 is indefinite because “image data” is used three times within the claim but it is unclear whether the “image data” is the same “image data” throughout the claim. In addition, if the “image data” is the same throughout the claim, then it is unclear how the data is being moved from one element of the wireless communication apparatus to the other as there is no recited connection between the elements.

Art Unit: 2617

17. Claim 16 is indefinite because it recites "image data," that has been sent from the wireless communication apparatus to the image server, but it does not indicate, which specific "image data" is being referred to.

18. Claim 19 recites the limitation "the communication equipment" in line 2. There is insufficient antecedent basis for this limitation in the claim.

19. Claim 20 is indefinite because it also recites "image data," that is being sent, but does not indicate, which image data.

20. Claim 21 is indefinite because the recited printing system incorporates indefinite claim 1 and further recites storing the image data, as in claim 16.

21. Claim 27 is indefinite because it is unclear what is meant by the limitation that the temporary storage means are upstream" from the "wired communication line."

22. Claim 28 is indefinite because the recited printing system incorporates indefinite claim 1 and further recites storing the image data, as in claim 2.

For purposes of the prior art rejections, the "image data" is being interpreted to be the same image data throughout each of the claims.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2617

23. Claims 1-3, 6-8, 11-13, 15-17, 20-22, 24-25, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0201709 to McIntyre et al.

McIntyre discloses all the elements of independent claim 1, including a wireless communication apparatus comprising:

wireless communication means (Figure 15, element 25) for carrying out data communication via a wireless communication network (element 50) with an imaging apparatus (element 23) having communication means (the antenna of element 23) for sending image data (paragraph 84) obtained by capturing means (Id.) to the wireless communication network (Id.) ; and

temporary storage means for temporarily storing the image data sent from the imaging apparatus (paragraph 62, element 70), wherein

wireless communication equipment (paragraph 84, the service provider 80) is connected via a wired communication line to a printing system for carrying out printing processing on the image data (paragraph 62, describes fulfillment provider 70 which gets the information from service provider 80 and prints the image data through printer 78, which is wired).

The Examiner notes that under MPEP section 2111.04, this wherein clause (of claim 1) is not being given significant patentably weight as it does not appear to limit the claim scope to a particular structure, as the “wireless communication equipment” does not relate in anyway to the elements of the claimed wireless communication apparatus,

which appears to comprise wireless communication means and temporary storage means.

The rejection of independent claim 1 is hereby incorporated. McIntyre discloses all the elements of independent claim 7, including a printing system comprising:

an image server (element 80) connected to at least one wireless communication apparatus of claim 1 via the wired communication line (Figures 1 and 15 and paragraph 62), for storing the image data sent from the wireless communication apparatus; and

a mini-laboratory for generating printed matter based on the image data stored in the image server (paragraph 62, the fulfillment center includes different types of printers).

The rejections of independent claims 1 and 7 are hereby incorporated. McIntyre discloses all the element of independent claim 15, including a wireless communication apparatus comprising:

wireless communication equipment (Figure 15, element 25) which carries out data communication via a wireless communication network (Figure 15, element 50) with an imaging apparatus (Figure 15, element 23) having a communication unit (the antenna of element 23) which sends image data (paragraph 84) obtained by an image capturing unit (paragraph 84) to the wireless communication network (element 50); and

a temporary memory (element 70) which temporarily stores the image data sent from the imaging apparatus (paragraph 62, the image data is transferred through element 80), wherein

Art Unit: 2617

the wireless communication equipment (element 25) is connected via a wired communication line (inherent in view of Figures 1 and 15 and paragraph 62) to a printing system (element 78) for carrying out printing processing on the image data (paragraph 62).

The rejections of claims 1, 7, and 15 are hereby incorporated. McIntyre discloses all the elements of independent claim 21, including a printing system comprising:

an image server (element 80, see description in paragraphs 55 and 84) connected to at least one wireless communication apparatus of claim 15 via the wired communication line (see above, Figures 1 and 15 and paragraph 62), for storing the image data sent from the wireless communication apparatus; and

a mini-laboratory for generating printed matter based on the image data stored in the image server (paragraph 62, the fulfillment center includes different types of printers).

The rejections of claims 1, 7, 15, and 21 are hereby incorporated. McIntyre discloses all the elements of independent claim 28, including a printing system, comprising:

an image server means (element 80) connected to at least one wireless communication apparatus of claim 1 via the wired communication line (Figures 1 and 15 and paragraph 62), for storing the image data sent from the wireless communication apparatus; and

a means for generating printed matter based on the image data stored in the image server means (paragraph 62, the fulfillment center includes different types of printers).

McIntyre disclose all the elements of dependent claims 2 and 16, including wherein the printing system comprises:

an image server (element 80) connected to the wireless communication apparatus via the wired communication line (Figures 1 and 15 and paragraph 62), for storing the image data sent from the wireless communication apparatus; and

a mini-laboratory (paragraph 62 and the fulfillment center includes different types of printers) element for generating printed matter based on the image data stored in the image server.

McIntyre also discloses all the elements of dependent claims 3, 8, 17, and 22 including wherein the printing system is installed in a DPE store. See, paragraph 82, which recognizes that the printing could be done in a retail store.

McIntyre also discloses all the elements of dependent claims 6 and 20, including wherein the imaging apparatus sends order information representing the content of a printing order regarding the image data, together with the image data. See, Figure 16 and paragraph 84.

McIntyre also discloses all the elements of dependent claims 11 and 24, including wherein the communication network enables communication with the imaging apparatus using a roaming function. This is inherent in view of Figure 15 and the corresponding description.

Art Unit: 2617

McIntyre also discloses all the elements of dependent claims 12 and 25, including said imaging apparatus including a device for selecting a printing format for the image data prior to output to the wireless communication network. See, Figure 16 and paragraph 84, specifically the operating push buttons.

McIntyre also discloses all the elements of dependent claims 13 and 26, including wherein the wireless communication equipment connects to the temporary storage means. See, Figures 1 and 15 and the corresponding descriptions, where the service provider 80 is connected to fulfillment center 70 and service provider 80 communicates through wireless network 50 and equipment 25.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 5, 14, 19, and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre.

McIntyre also discloses all the elements of dependent claims 5 and 19, except wherein the communication means/equipment of the imaging apparatus is installed in a communication chip. However, the Examiner takes Official Notice that it is well known in the art to use microchips of various forms to control communication functions, one example is the proliferation of SIMs. Therefore, one of ordinary skill in the art would

Art Unit: 2617

have known and understood that the imaging apparatus of McIntyre would use a communication chip to control its wireless communication with a wireless network.

McIntyre also discloses all the elements of dependent claims 14 and 27, except wherein the temporary storage means are upstream from the wired communication line. While this limitation is not definite, the Examiner is interpreting it to be a design choice and thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have arranged the temporary storage means, the wireless communication equipment, and the wired communication line in such a manner as to meet the system requirements.

26. Claims 4, 9, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre in view of Admitted Prior Art.

McIntyre teaches all the elements of dependent claims 4, 9, 18, and 23, except wherein the wired communication line is an ADSL. However, Applicant admits that ADSL wired communication lines are well known. See, page 3, line 4 of the originally filed application. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an ADSL wired communication line as the wired line in McIntyre because they have high speed.

Response to Arguments

27. Applicant's arguments with respect to claims 1-9 and 11-29 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2617

28. The previous claim objections and 35 U.S.C. 112 second paragraph rejections are withdrawn. However it is noted that new rejections have now been presented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner draws the Applicant's attention to the Fedex/Kinko's web site, <http://www.fedex.com/us/officeprint/main/?link=4> , which includes information related to the Fedex/Kinko's stores. Specifically, the Examiner strongly suggests that the claims as currently presented appear to be anticipated or alternatively obvious in view of this web site, for example, the site describes WiFi services and the ability to download and print pictures at their stores via wireless networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES
TES

George Eng
GEORGE ENG
SUPERVISORY PATENT EXAMINER